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Atty's Docket:Kreislser 1089-KGB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

SERIAL NO.	: 09/600,564
APPLICANT	: FLORIAN KERN ET AL.
FILED	: 7 November 2000
	: K.S. Shahnian Shah
EXAMINER	: 1645
ART UNIT	: METHOD FOR IDENTIFYING T-CELL STIMULATING
FOR	PROTEIN FRAGMENTS

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

July 14, 2004

AMENDMENT AND REQUEST FOR RECONSIDERATION  
PURSUANT TO 37 CFR § 1.116

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ES  
9/20/04

Sir:

This amendment after final action is in response to the office action of May 4, 2004.

JUL 14 2004

**FAX COVER SHEET**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****TOTAL PAGES (PLUS COVER SHEET) = 12**

**TO**  
**ATTENTION** : K.S. Shannan Shah  
**ART UNIT** : 1645  
**FAX NUMBER** : 703 872-930<sup>7</sup><sub>4</sub>

**RE**  
**SERIAL NO.** : 09/600,564  
**APPLICANT** : FLORIAN KERN ET AL.  
**FILED** : 7 November 2000  
**FOR** : METHOD FOR IDENTIFYING T-CELL STIMULATING  
PROTEIN FRAGMENTS

**PLEASE EXPEDITE****RESPONSE TO FINAL ACTION**

July 14, 2004

Attached please find:

- RESPONSE UNDER RULE 116

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*OK to Enter  
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a/Reley*  
**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

**ADDITIONAL FEES**

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

**REMARKS**

Claims 14-<sup>26</sup>~~22~~ are pending in the application.

In addition, the first page of the specification has been amended to include the required priority information. This provided on a separate sheet attached hereto.

No claim has been amended.

**Anticipation by Woitas**

Applicants respectfully request withdrawal of the anticipation rejection, as it is predicated on a misreading of the Woitas reference.

A key element of the claimed method is that the incubation of T-cells with antigen is performed for a period of time that was much shorter than previously known in the art. The practical value of this method is that it allows determination of the response repertoire of the entire population of cells to the antigen. The entire population of unstimulated and stimulated cells can be determined because the cells do not proliferate. It is during the proliferation period that stimulated cells are likely to die due to stimulation-induced apoptosis. This problem is not alleviated by methods known in the art, e.g., Woitas.

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The crux of Examiner's rejection lies in her belief that Woitas teaches incubating T-cells with antigens for only 30 minutes, thus, avoiding the stimulation-induced apoptosis. However, this is incorrect.

The method that Examiner relies on is on page 1013 of Woitas. This method is directed solely to labeling of cells with antibodies prior to flow cytometry. This step is at least 40 hours after the stimulation period begins. See page 1013, col. 2. The 30 minute incubation refers to antibody-labeling of paraformaldehyde-fixed (i.e., dead) cells. This is not connected in any way to the actual stimulatory step.

Therefore, contrary to Examiner's belief that Woitas teaches incubating T-cells with antigen for up to 40 hours, he teaches only 40 hours. See page 1013, col. 2, *Cells and Culture*. Therefore, Applicant's method is fundamentally different in that the brief incubation time provides a result that Woitas' method is incapable of providing.

Examiner is respectfully reminded that it is well established prosecution practice that a proper reference under 35 USC 102 must be enabling in the sense of 35 USC 112, paragraph 1. *In re Le Grice*, 133 USPQ 365, 374 (CCPA 1962). However, Woitas is not enabling to that extent. Woitas does not provide any disclosure of this problem or of how persons of ordinary skill may solve or avoid it. Thus, Woitas cannot be considered an enabling reference for the purposes of rejecting the claims by anticipation.

**CONCLUSION**

In view of the foregoing remarks, Applicants request withdrawal of the anticipation rejection.

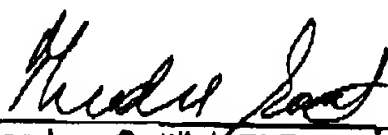
Woitas does not provide a method that explicitly or inherently anticipates the claimed method. Further, it does not provide an enabling disclosure.

The rejection should be withdrawn.

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Respectfully Submitted,

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